

Serial No.: 10/614,140  
Docket No.: LOCH1  
Amendment dated February 18, 2005  
Responsive to Office Action dated December 3, 2004

### REMARKS

Prior to the present Office Action, claims 1-24 were pending, with claims 8 and 19 being withdrawn as being drawn to a non-elected species. Claims 1-24 remain pending, and therefore no fees are due, the Amendment being filed within the 3-month time for response.

5 The undersigned wishes to thank the Examiner for a constructive and courteous telephonic interview on February 3, 2005 during which the rejections under 35 U.S.C. §112, second paragraph were discussed.

The Examiner objects to the Abstract because of inclusion of the term "improved." Accordingly, the abstract has been amended to remove this term.

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#### Discussion of Indefinite Rejections under 35 U.S.C. §112:

Claims 1, 3, 5, 10-13, and 20 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Prior to a discussion of the main issue, Applicant notes that the tentative term "may" has been removed from claims 3 and 5. Also, claims 10 and 11 have been amended  
15 merely to facilitate prosecution, although Applicant disagrees that they are indefinite in their original form and reserve the right to present them at a later date.

To provide further clarity, each independent claim has been amended as indicated above to first set forth the skateboard parameters relative to which the rack is defined. One of skill in the art can easily ascertain these parameters for any given skateboard, and therefore the definition  
20 of the security rack as claimed can easily be understood. There does not appear to be a definiteness issue.

The Examiner stated in the telephone interview that terms in the claims that are defined relative to a skateboard are indefinite (or functional) because, quoting from the Office Action, "a skateboard is not an element of the claimed device and it is improper to seek to define claim  
25 structure based on a comparison to some unclaimed element." This apparent *per se* standard for 35 U.S.C. §112, second paragraph is not consistent with Federal Circuit law, and runs counter to the directive to examiners against *per se* rules in MPEP §2173.02 (p. 2100-206).

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With regard to the present claims, please refer to the following paragraph in MPEP §2173.05(b):

**REFERENCE TO AN OBJECT THAT IS VARIABLE MAY RENDER A CLAIM INDEFINITE**

A claim may be rendered indefinite by reference to an object that is variable. For example, the Board has held that a limitation in a claim to a bicycle that recited "said front and rear wheels so spaced as to give a wheelbase that is between 58 percent and 75 percent of the height of the rider that the bicycle was designed for" was indefinite because the relationship of parts was not based on any known standard for sizing a bicycle to a rider, but on a rider of unspecified build. *Ex parte Brummer*, 12 USPQ2d 1653 (Bd. Pat. App. & Inter. 1989). On the other hand, a claim limitation specifying that a certain part of a pediatric wheelchair be "so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats" was held to be definite. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). The court stated that the phrase "so dimensioned" is as accurate as the subject matter permits, noting that *the patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.* (emphasis added) *Orthokinetics* at F.2d 1565, 1 USPQ2d 1088

This passage in the official Manual of examination guidelines is directly on point, and at the very least refutes any *per se* rule that referring in a claim to an unclaimed element is indefinite. The present claims are defined in a similar manner as those at issue in *Orthokinetics* in which the Federal Circuit reversed the District Court's decision that held certain claims invalid for indefiniteness under 35 U.S.C. §112. The wheelchair claim at issue in *Orthokinetics* contained the limitation "wherein said front leg portion is *so dimensioned* as to be insertable through the space between the doorframe of an automobile and one of the seats thereof." In deciding that the flexible phrase "so dimensioned" was sufficiently definite, the Federal Circuit explained that it was not the role of the claims to describe the invention. Instead, the court stated that "[t]he phrase 'so dimensioned' is as accurate as the subject matter permits, automobiles being of various sizes... as long as those of ordinary skill in the art realized that the dimensions could be easily obtained, section 112, 2d ¶ requires nothing more. The patent law does not

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require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims." Significantly, there was no discussion of whether this phrase was functional or not, the court treated it as a structural limitation and merely dealt with whether it was definite or not.

5           *Orthokinetics* remains the leading case on this point. Please see *Oakley, Inc., v. Sunglass Hut International, et al.*, 316 F.3d 1331, \_\_\_ USPQ3d \_\_\_ (Fed. Cir. 2003) which notes that *Orthokinetics* stands for one of the "canons...that claims are construed as one skilled in the art would understand them in light of the specification of which they are a part [citing *Orthokinetics* 806 F.2d at 1575, 1 USPQ2d at 1088]". Also see *Moore U.S.A., Inc., v. Standard Register Company*, 229 F.3d 1091, 56 USPQ2d 1225 (Fed. Cir. 2000) "[W]e note that there is nothing  
10           wrong with defining the dimensions of a device in terms of the environment in which it is to be used [citing *Orthokinetics* 806 F.2d at 1575-76, 1 USPQ2d at 1087-88]".

          With regard to the present claims, Applicant asserts that one of skill in the art would understand what is claimed, especially in light of the specification, and therefore there is no  
15           section 112, 2d ¶ issue. As a matter of law, a patent "shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as the invention." 35 U.S.C. §112 2d ¶ *Orthokinetics* stands for the proposition that explicit detail to define a claim element is not necessarily required. The terms in amended claim 1, for example, refer to a) a portion that extends normally away from the base to a height dimension at  
20           least as great as the skateboard deck width, b) a first one of the support members having a maximum width dimension smaller than the skateboard wheelbase, and c) the support members being adapted to mount in parallel to one another at a distance apart that is greater than the skateboard deck thickness but less than the skateboard height. These phrases used to describe elements of the skateboard security rack relative to parameters of a skateboard are exactly  
25           analogous to the "so dimensioned" limitation at issue in *Orthokinetics*. Indeed, the first phrase could be reworded to read as follows: a portion that extends normally away from the base and is *so dimensioned* as to have a height at least as great as the skateboard deck width. Applicant

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respectfully asserts that the number of differently sized skateboards is no greater than the "spaces in hundreds of different automobiles" referred to by the Federal Circuit in *Orthokinetics*. If the Federal Circuit found the aforementioned claim definite in *Orthokinetics*, then the present claims are also definite. To quote from *Orthokinetics* again with only a slight modification, the present  
5 claims "are as accurate as the subject matter permits, [skateboards] being of various sizes."

The Examiner also indicated in the Office Action that "the boundaries of the claim cannot be properly ascertained because one would not know whether their device infringed the instant claim until someone else later added a skateboard. In other words, a device as defined in the claims would infringe the claim with one particular skateboard while the exact same device  
10 would not infringe the claim when another skateboard is used." This rationale presumes that the skateboard security rack defined in the present claims must work with every size of skateboard. However, the Federal Circuit in *Orthokinetics* did not seem to find a problem that there were hundreds of different spaces relative to which the claim element might be "so dimensioned," and therefore the wheelchair may not fit through spaces in some cars. Likewise, a skateboard  
15 security rack in accordance with the present invention might work with skateboards of various sizes, even if it does not work with every single skateboard. In the hypothetical example given by the Examiner, a particular device constructed in accordance with the claim will receive at least one size of skateboard, but may not receive all others. Any alleged infringer who constructs or sells a skateboard security rack that secures at least one size of skateboard would infringe the  
20 claim, even if it did not secure all sizes of skateboard. Just as the Federal Circuit in *Orthokinetics* did not require the front leg portion of the wheelchair to be insertable through all the differently dimensioned spaces between the doorframe of an automobile and one of the seats ("automobiles being of various sizes"), neither should the Patent Office require that the presently claimed skateboard security rack work with every size of skateboard to be definite.

25 In the telephonic interview, the Examiner also indicated a potential future rejection even if the claims are held now to be definite because of certain alleged functional language within the claims. Specifically, the Examiner stated that any functional language within an apparatus claim

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might not be given any patentable weight, as a rule. Again, this rigid *per se* application of a patentability standard that does not appear in 35 U.S.C. §112 and runs counter to established jurisprudence. Indeed, there is a specific MPEP section that is on point as follows:

**2173.05(g) Functional Limitations**

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. Whether or not the functional limitation complies with 35 U.S.C. 112, second paragraph, is a different issue from whether the limitation is properly supported under 35 U.S.C. 112, first paragraph, or is distinguished over the prior art. A few examples are set forth below to illustrate situations where the issue of whether a functional limitation complies with 35 U.S.C. 112, second paragraph, was considered.

It was held that the limitation used to define a radical on a chemical compound as "incapable of forming a dye with said oxidizing developing agent" although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971).

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

In any event, Applicant disagrees that the claim terms at issue are functional. As explained in the MPEP a "functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients)." The terms at issue which relate the size of the skateboard rack to parameters of the skateboard

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actually define the skateboard rack by what it is, not by what it does. Therefore, these terms are not functional.

Even if the terms are viewed as functional, the official guidelines for examination provide that "[T]here is nothing inherently wrong with defining some part of an invention in functional terms." In fact, each of the examples cited found the functional limitations to be definite.

Accordingly, even if the Examiner still considers the claim terms at issue to be functional, there is nothing intrinsically wrong such that they carry no patentable weight. Instead, functional limitations are perfectly proper to define an invention, and only when those limitations are inherent in the prior art do they become superfluous (e.g., one cannot obtain an apparatus claim to an old structure merely by defining it as having a new purpose).

#### Discussion of Anticipation Rejections under 35 U.S.C. §102:

Prior to a discussion of the specific rejections, Applicant assumes that the rejections under 35 U.S.C. §112 have been overcome. Consequently, the following statements regarding the differences between the claims and cited prior art references are made assuming that all of the language in the claims has been given patentable weight: and specifically that none of the claim language has been disregarded as being "functional."

#### Draper

Claims 1, 2, 7, 9-11, 12, 17, and 20-23 stand rejected under 35 U.S.C. §102(b) as being anticipated by Draper (USPN 6,293,412). Draper discloses a rack for hanging a conventional skateboard from its trucks and subsequently locking it to the rack. Figures 1-4 show a primary embodiment of the rack, Fig. 5 shows a multiple rack assembly, and Figs. 6 and 7 show alternative racks. As described at column 2, lines 15-20, "the skateboard rack 20 comprises a pair of struts 22A and 22B in spaced relation to one another and connected to one another by a cross bar 24. As can be seen, the struts 22A and 22B are not straight, but in fact include an elbow 26A and 26B and finally terminate in an upwardly turned bottom end 28A and 28B." As seen in

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Fig. 3, a skateboard hangs from the rack with the upturned bottom ends 28A and 28B extending between the skateboard wheels and its deck. The wheels rest on the elbows 26A and 26B. A locking ring 32 is placed over the wheels and locked in place through aligned apertures 34, 36. The Examiner analogizes the elbows 26A, 26B in Draper with the "support members" of the present claims. The Examiner correctly finds locking structure for holding a skateboard to the rack 20, but other than this the structure in Draper and the structure as defined in the present claims are quite different.

The support members in the claims each have a base and a portion that extends normally away from the base to a height dimension at least as great as the skateboard deck width. One of the support members has a maximum width dimension smaller than the skateboard wheelbase, and the support members are adapted to mount in parallel to one another at a distance apart that is greater than the skateboard deck thickness but less than the skateboard height. A slot is defined between the support members for receiving the skateboard. The elbows 26A, 26B in Draper are spaced apart and thus define a slot.

To help compare the present claims with the structure in Draper, please refer to the attached sheet of drawings from Draper showing Fig. 2. The slot dimension C or distance between the elbows 26A, 26B can be assigned to the x-axis. The two dimensions that are orthogonal to the slot dimension C have been labeled as A and B. There are only two possible orthogonal relationships as indicated at 1) and 2), pursuant to the right-hand-rule. The claims provide that the distance apart of the support members is defined relative to the deck thickness or skateboard height. Aside from the distance apart of the support members, the two dimensions of the skateboard rack of the present invention that are defined are the height dimension and the width dimension. There are only two possible comparisons of the skateboard rack in Draper with the rack as presently claimed: Case 1) A extends along the y-axis and B along the z-axis, or Case 2) A extends along the z-axis and B along the y-axis.

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To anticipate, the following relationships must be disclosed in Draper:

Case 1)

x-axis: deck thickness < slot dimension < skateboard height, and

y-axis:  $A \geq$  deck width, and

z-axis:  $B <$  skateboard wheelbase, or

Case 2)

x-axis: deck thickness < slot dimension < skateboard height, and

y-axis:  $B \geq$  deck width, and

z-axis:  $A <$  skateboard wheelbase of

With reference to Fig. 3 of Draper in which the size of a skateboard is shown against the rack:

In case 1, the dimension A is clearly less than a skateboard deck width.

In case 2, the dimension B is clearly less than a skateboard deck width.

Accordingly, Applicant asserts that Draper does not anticipate claims 1, 12, or 20. Likewise, Applicant believes that claims 1, 2, 7, 9-11, 12, 17, and 20-23 are allowable over Draper. In particular, claims 10 and 11 have been amended to clearly distinguish over the structure shown in Draper.

#### Kennelly

Claims 1-7, 9, 12-18, 20-21, and 24 stand rejected under 35 U.S.C. §102(b) as being anticipated by Kennelly (USPN 3,785,500). Kennelly discloses a bicycle rack including a pair of longitudinal base members 12 and 14 to which are attached a plurality of inverted U-shaped wheel receiving members 16. A plurality of brace members 26 help support alternating wheel receiving members 16 at opposite angles. It is unclear what elements of the structure that the



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Examiner deems to be analogous to the support members of the claims, as the element number 26 and 28 consist, respectively, of the brace members 26 and the free ends 28 thereof.

In any event, Kennelly does not disclose the skateboard security rack of claims 1, 12 and 20. These claims all provide spaced apart support members which are sized relative to a skateboard. The bicycle rack of Kennelly defines slots for bicycle wheels, but these slots are not sized to receive a skateboard, and the aforementioned dimensions of the support members are not found in the bicycle rack, regardless of what elements are viewed as the support members. Once again, Applicant assumes that the section 112 rejection has been overcome, and therefore all of the elements of the claims should be given weight. Accordingly, Applicant asserts that claims 1-7, 9, 12-18, 20-21, and 24 are allowable over Kennelly.

If the Examiner believes that Kennelly still applies, Applicant respectfully requests a more detailed recitation of the structure in Kennelly that anticipates the skateboard security racks as claimed, as required by 37 C.F.R. §104.

15 Theriault

Claims 12-17, 20-22, and 24 stand rejected under 35 U.S.C. §102(b) as being anticipated by Theriault (USPN 5,096,068). Theriault also discloses a bicycle rack having a base and plurality of pairs of guiding rails 16 each having a generally trapezoidal shape mounted thereon. The guiding rails laterally support the bicycle wheels.

20 Applicant disagrees that the bicycle rack of Theriault discloses the skateboard security rack of the present claims. Although there are pairs of guiding rails spaced apart for supporting bicycle wheels, they do not have the attributes of the claimed skateboard security rack. The spacing between the guiding rails may not be less than the height dimension of the skateboard, the width of none of the guiding rails is less than the skateboard wheelbase, and the height of the  
25 guiding rails are certainly not less than a skateboard deck width.

Discussion of Obviousness Rejections under 35 U.S.C. §103:

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Claims 18 stands rejected under 35 U.S.C. §102(b) as being obvious over Theriault in view of Kemery, et al. (USPN 6,263,709). Applicants respectfully assert that because Theriault does not anticipate claims 12-17, that the addition of Kemery cannot render claim 18 obvious.

5 Summary

Based on the above remarks and amendments, Applicant believes that claims 1-24 are in condition for allowance and such action is respectfully requested. Furthermore, Applicant requests reinstatement of withdrawn claims 8 and 19 as being dependent from an allowable base claim. If there is any further hindrance to allowance of the claims, the Examiner is encouraged to  
10 contact the undersigned by telephone.

15 Date: February 18, 2005

Respectfully submitted,

  
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